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FROM: Christine A. Gritzmacher
Gen-Probe Incorporated
10210 Genetic Center Drive
San Diego, California 92121

Phone No.: 858-410-8926
Facsimile No.: 858-410-8928

TO: Commissioner for Patents
P.O. Box 1450
U.S. Patent & Trademark Office
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In re patent application of:

NORMAN et al.

Appln. No. 10/712,654

Filed: November 12, 2003

Title: ASSAY AND COMPOSITIONS FOR DETECTION OF BACILLUS ANTHRACIS NUCLEIC ACID

Group Art Unit: 1645

Examiner: Baskar, P.V.

Confirmation No. 8961

Docket No.: GP141-03.UT

Date: March 13, 2006

Response to Restriction Requirement via Facsimile includes:

1. Response to Restriction Requirement under 35 USC 121 - 4 pgs.

I hereby certify that this correspondence, along with the attached documents, is being facsimile transmitted to the US Patent and Trademark Office (FAX No. 571-273-8300) on the date indicated below.

Date: March 13, 2006

By: Christine A. Gritzmacher
Christine A. Gritzmacher
Registration No. 40,627

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Norman et al.	Examiner: Baskar, Padmavathi V.
Serial No.	10/712,654	Group Art Unit: 1645
Filed:	November 12, 2003	Confirmation No. 8961
For:	ASSAY AND COMPOSITIONS FOR DETECTION OF BACILLUS ANTHRACIS NUCLEIC ACIDS	Docket No.: GP141-03.UT

RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. §121

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office action mailed on March 2, 2006, which required an election of claims, Applicants' reply is timely filed.

Claims 1 to 33 are pending. The Examiner alleges that the claims are directed to five distinct inventions:

Group I, product claims 1-6, 14, 17 and 32-33, drawn to oligonucleotides that hybridize specifically to *pagA* target sequences and a kit comprising such oligonucleotides;

Group II, product claims 1, 7-9, and 32-33, drawn to oligonucleotides that hybridize specifically to *capB* target sequences;

Group III, product claims 10-11, 15, 18, and 32-33, drawn to oligonucleotides that hybridize specifically to 16S rRNA of *Bacillus* species target sequences;

Group IV, product claims 12-13, 16, 19, and 32-33, drawn to oligonucleotides that hybridize specifically to 23S rRNA of *Bacillus* species target sequences; and

Group V, process claims 20-31 drawn to methods of detecting *B. anthracis* by using products I or II or III or IV.

All of the groups are classified in class 435, but are in different subclasses (subclasses 91.1 and 810 for Groups I, II, III and IV, and subclass 6 for Group V).

The Examiner stated that because the products are each structurally, biochemically and functional different, they constitute patentably distinct inventions which have materially different physical and chemical properties and structures, as represented by their different target sequences. The Examiner alleges that searching and examining the claims of the Groups I-V together would place a serious burden on the Office.

The Office action appears to contain typographical errors related to the Group numbers on page 2, line 17 and page 3, line 7. That is, after describing Groups I to V in paragraph 1, paragraph 2 then states "Group I is directed to different oligonucleotides that hybridize specifically to pagA target sequence, capB target sequence, 16S rRNA of Bacillus species and 23S rRNA of Bacillus species" (page 2, lines 17-19) and "Group II is drawn to different methods of treatment using different products as discussed above" (page 3, lines 7-8). Applicants presume that, instead, paragraph 2 meant to say "Groups I to IV are directed to different oligonucleotides that hybridize specifically to pagA target sequence, capB target sequence, 16S rRNA of Bacillus species and 23S rRNA of Bacillus species" (at page 2, lines 17-19, edits underlined) and "Group V is drawn to different methods of detecting B. anthracis by using different products as discussed above" (at page 3, lines 7-8, edits underlined), consistent with the description of Groups in paragraphs 1 and 3. To expedite prosecution, Applicants respond to the restriction requirement as if paragraph 2 included the statements as edited above. If Applicants' interpretation of the presumed typographical errors is incorrect or inaccurate, Applicants request that the Examiner issue a corrected Office action or otherwise contact Applicants' representative by telephone to clarify the correct interpretation of this restriction requirement.

Applicants also respectfully note that claims 32 and 33 do not recite oligonucleotide sequences that hybridize specifically to 16S or 23S rRNA sequences.

Although Applicants agree that the products (oligonucleotides) are structurally different and, therefore, constitute patentably distinct inventions, and that the products and methods are distinct inventions, Applicants respectfully traverse the restriction requirement because dividing the present application into multiple applications defined by the Groups will effectively use greater resources of the US Patent and Trademark Office than examining the inventions together as a whole, as presented in the disclosure. That is, if multiple applications result from this restriction requirement, then each application will have to be reviewed and examined separately in a piecemeal manner, requiring greater resources of the examining division than would be required to review the application as a whole. Applicants have relieved some of the searching burden on the Office by already submitting four Information Disclosure Statements. Moreover, four of the five Groups are in the same class and subclasses, thus showing the relatedness of the inventions. Therefore, Applicants respectfully request that the Examiner reconsider this restriction requirement and examine all of the groups in one application.

In the event that the restriction requirement is maintained and to be responsive to the restriction requirement, including the presumed edits to paragraph 2 discussed above, Applicants provisionally elect Group I product claims (claims 1-6, 14, 17, and 32-33) drawn to oligonucleotides that hybridize specifically to the pagA target sequence. Applicants thank the Examiner for the reminders related to rejoinder of process claims as a matter of right (paragraphs 7 and 8) and inventorship issues (paragraph 9). In the event that the restriction requirement is maintained, Applicants intend to submit a preliminary amendment of the claims that will include amendments to the withdrawn process claims to maintain the right to rejoinder. Therefore, if the restriction requirement is maintained, Applicants respectfully ask the

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RESPONSE TO RESTRICTION REQUIREMENT
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Examiner to contact their representative by telephone or facsimile in order to expedite prosecution so that a preliminary amendment may be submitted for examination of claims consistent with the Examiner's decision on the restriction requirement. Applicants' representative's telephone and facsimile numbers are provided below.

I hereby certify that this correspondence (along with any referred to as being attached or enclosed) is being facsimile transmitted (FAX No. 571-273-8300) to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Respectfully submitted,

Date: March 13, 2006

By: Christine A. Gritzmacher
Christine A. Gritzmacher
Reg. No. 40,627

GEN-PROBE INCORPORATED
Patent Department
10210 Genetic Center Drive
San Diego, California 92121
Tel.: (858) 410-8926
FAX: (858) 410-8928